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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,796	12/07/2000	Yuji Tsukamoto	Q62199	8889

7590 02/25/2005

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EXAMINER	
HUYNH, SON P	

ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/730,796	TSUKAMOTO ET AL.	
	Examiner	Art Unit	
	Son P Huynh	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 December 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3 and 4*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 3-9 are objected to because of the following informalities:

In claim 3, line 5, the limitation "when the first option is selected" should be replaced as- when the second option is selected- see the specification, page 5, lines 22-25.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1- 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Slezak (US 6,006,257).

Regarding claim 1, Slezak discloses a television broadcasting system (figure 1) comprising a broadcast service equipment (video server 520) disposed at a

broadcasting side for delivering chargeable programs (primary program) and advertisement programs (secondary program) – col. 5, lines 47-52), and a plurality of set top boxes (STBs) (set top box units 504) each disposed at a subscriber side for receiving the chargeable programs and the advertisement program to display the chargeable programs and the advertisement programs on a screen (figures 1, 5; col. 5, lines 42-60; col. 8, lines 18-40), each of the STBs having a function for selecting a charging system among a plurality of charging systems (free, half price or full price) based on a viewing type (with a lot advertising, with minimal advertising, or with no advertising) of the subscriber side with respect to viewing the chargeable programs and the advertisement program (viewer uses a remote control, a keyboard or a mouse to input whether the viewer wishes to receive the movie for free, with a lot of advertising, for half price with minimal advertising, or for full price with no advertising- see col. 8, lines 18-42).

Regarding claim 2, Slezak further discloses the subscriber side selects, before viewing one of the chargeable programs, either a first option for viewing no advertisement program (with full price) and a second option for viewing at least one of the advertisement programs together with the one of the chargeable programs (with half price or free) – see col. 8, lines 18-42). As a result, the broadcasting side sets a first charging system (full price) or a second charging system (half price or free) depending on the first option or the second option.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak (US 6,006,257) as applied to claim 2, and in view of Kitsukawa et al. (US 6,282,713).

Regarding claim 3, Slezak discloses the system as discussed in the rejection of claim 2. Slezak further discloses each of the STBs allows the at least one of the advertisement programs to be displayed on the screen during displaying of the one of the chargeable programs when the second option (view program with advertising) is selected (col. 8, lines 18-42; col. 9, lines 39-56). However, Slezak does not specifically disclose the advertisement program to be displayed as an advertisement icon.

Kitsukawa teaches advertisement program to be displayed as an advertisement icon (512, 522, - figure 5, col. 8, lines 37-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Slezak to use the

teaching of using an icon as taught by Kitsukawa in order to improve efficiency in utilization of space on the screen.

Regarding claim 4, Slezak in view of Kitsukawa teaches a system as discussed in the rejection of claim 3. Slezak further discloses the viewer select whether the viewer wishes to view the movie, for full charge without advertising, the same movie for half charge with some advertising presented during the movie, or the same movie at no charge with interactive advertising and questions (col. 3, line 63-col. 4, line 13). Furthermore, Kitsukawa discloses a click of the advertisement icon to display one of the advertisement programs on the screen (col. 2, lines 49-60; col. 7, lines 22-40; col. 8, lines 38-55) and providing electronic coupon associated with the item (10, lines 37-45). It is obvious to one of ordinary skill in the art that clicking the icon allows the broadcasting side to set a charging system, which charge lower fee in order to attract the viewer to view the advertisement.

Regarding claim 5, Slezak further discloses each of the STBs has an Internet function (using web browser) for receiving advertisement data for display thereof on the screen during display of one of the advertisement program (figure 1, col. 5, lines 34-60; col. 8, lines 45-52).

Regarding claim 6, Slezak in view of Kitsukawa teaches a system as discussed in the rejection of claim 5. Slezak further discloses the viewer select whether the viewer

wishes to view the movie, for full charge without advertising, the same movie for half charge with some advertising presented during the movie, or the same movie at no charge with interactive advertising and questions (col. 3, line 63-col. 4, line 13). Slezak additionally disclose accessing to advertisement data via the Internet (530 – figure 1 and col. 5, lines 34-53). It is obvious that another charging system which charges a lower fee (e.g. half charge) is set in order to attract viewer to access advertisement data.

Regarding claim 7, Slezak in view of Kitsukawa teaches a system as discussed in the rejection of claim 6. Kitsukawa further discloses providing coupon associated with particular items (figure 9), the coupon can be redeemed by the viewer (col. 11, line 61-col. 12, line 32). It is obvious to one of ordinary skill in the art that purchasing of a commodity in connection with one of the advertisement program allows the charging system to be set at a lower fee in order to attract viewer to purchase the commodity.

6. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak (US 6,006,257) in view of Kitsukawa et al. (US 6,282,713) as applied to claim 3, and further in view of Picco (US 6,029,045).

Regarding claim 8, Slezak in view of Kitsukawa teaches a system as discussed in the rejection of claim 3. Kitsukawa further discloses storage device (DRAM 25a) for storing

video programs (col. 5, lines 47-52). However, neither Slezak nor Kitsukawa specifically disclose storing the program after one of the advertisement icon is clicked.

Picco teaches storage device (disk) for storing one of chargeable program (television program) after one of the advertisement icons is click (viewer selects to activate web browser to browse the web – col. 13, lines 24-32; col. 14, lines 20-40, figure 11). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Slezak and Kitsukawa to use the teaching as taught by Picco so that the user does not miss any of the television programming during the web browsing (col. 13, lines 25-35).

Regarding claim 9, Picco further discloses the chargeable program is displayed in a time shift display scheme after the chargeable program is restarted from the temporary stop by the click of the advertisement icon (the set top box playback the programming data stored while the user was browsing the web – col. 14, lines 34-41).

Regarding claim 10, the limitations of the method as claimed correspond to the limitations of the system as claimed in claims 1-3, 8-9, and are analyzed as discussed with respect to the rejections of claims 1-3, 8-9.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Candelore (US 6,057,872) teaches digital coupon for pay televisions.

Itoh et al. (US 6,282,293 B1) teaches system and method for charging fee for video information.

Freeman et al. (US 5,861,881) teaches interactive computer system for providing an interactive presentation with personalized video, audio and graphic response for multiple viewers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P Huynh whose telephone number is 703-305-1889. The examiner can normally be reached on 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Son P. Huynh
February 10, 2005

HAI TRAN
PRIMARY EXAMINER